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ART UNIT	PAPER NUMBER
3623	

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>01 February 2002</u>.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-42</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-42</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>20020227</u>.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   The following is a non-final, first office action on the merits. Claims 1-42 are pending.

Claim Rejections - 35 USC § 112

2.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3.   Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for

failing to particularly point out and distinctly claim the subject matter which applicant regards as

the invention.

Claim 11 recites the limitations "the licensee product" and "the licensee customer".

There is insufficient antecedent basis for these limitations in the claim. Appropriate correction is

required. For examination purposes, the limitations have been construed as --a licensee

product-- and --a the licensee customer--.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5.   Claims 1, 2-3, 9-11, 13-18, 26-28, 31, and 33-38 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Nutter et al. (U.S. 2002/0178029).

As per claim 1, Nutter et al. teaches a tool to prioritize opportunities by assigning a

relative calculated value to every opportunity, the tool comprising:

at least one module having a plurality of value drivers (See figure 7, paragraphs 0025,

0029, 0039, which discusses the system storing parameters that drive value);

a plurality of user-specified variables in response to the value drivers (See paragraphs

0019, 0022, 0025-6, 0039, which discloses a user inputting variables into the system in response

to the parameters);

a database coupled to the tool that stores data concerning the evaluation (See figures 1

and 2, paragraphs 0021, 0046); and

a processor operative to calculate an opportunity value for each entered opportunity by a

pre-determined function using said user-specified variables and to prioritize the calculated

opportunity values (See paragraphs 0019, 0021, 0026, 0028, 0030-1, wherein a function is used

to calculate a value based on the input variables by the user and the values are ranked, sorted,

and/or prioritized).

However, Nutter et al. does not expressly disclose storing the calculated opportunity

values for each entered opportunity.

Nutter et al. discloses a database coupled to the tool (and processor) that stores data

concerning the evaluation as well as calculating an opportunity value for each entered

opportunity using a scoring function. Databases are old and well known in the art for collecting

and organizing information so that it can easily be accessed and used, managed, and updated.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the

invention to store the calculated opportunity values (which are manipulated by the computer of

Nutter et al.) in the database of the system in order to more easily eliminate intellectual

properties from licensing choices by use of the computer. See paragraphs 0019, 0021, which

discusses the use of databases and computers to more easily access the opportunities.

As per claim 2, Nutter et al. discloses wherein pre-determined weighting factors are

applied to each of the plurality of value drivers (See paragraphs 0025, 0027, 0030, which

discloses weighting factors used in the scoring of the value drivers).

As per claim 3, Nutter et al. teaches wherein the at least one module comprises a market

module having a plurality of value drivers relating to the marketability of the entered opportunity

(See figure 7, paragraphs 0028-32 and 0034, wherein the market of the opportunity is considered

in the evaluation).

As per claim 9, Nutter et al. teaches wherein the at least one module comprises an

efficiency module having a plurality of value drivers relating to efficiency of the entered

opportunity (See figure 7, 13, paragraphs 0025, 0030, 0034, which at least discloses ease of

investigation, strength of claims, all of which are directed towards the effectiveness of the

opportunity).

As per claim 10, Nutter et al. discloses calculating an opportunity value for each

opportunity using a pre-determined function using variables related to various factors (See

paragraphs 0019, 0021, 0026, 0028, 0030-1, 0034, wherein a function is used to calculate a value

based on the input variables by the user and the values are ranked, sorted, and/or prioritized).

However, while Nutter et al. teaches a plurality of licensing and market factors, Nutter et

al. does not expressly disclose factors relating to value drivers relating to the efficiency of

employee job, job knowledge, job tasks, and employee-customer relations for the entered

opportunity.

Nutter et al. discloses rating a licensing opportunity using a scoring function including factors related to the market and industry in which the opportunity resides. It is well known in the art that when a new product or opportunity is introduced to an organization that employee job, job knowledge, job tasks, and employee-customer relations must be considered to ensure that the organization is capable of handling the new product/opportunity. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include the factors of employee job, job knowledge, job tasks, and employee-customer relations with the factors used in the scoring function of Nutter et al. in order to more efficiently evaluate intellectual properties and eliminate intellectual properties that do not score as well as others based on the same evaluation factors. See paragraph 0019, 0026, of Nutter et al.

As per claim 11, Nutter et al. wherein the at least one module comprises an impact module having a plurality of value drivers relating to overall impact of the entered opportunity on the licensee product and licensee customers (See paragraph 0034, which discloses considering the impact of the license on the products of the customer using the license).

As per claim 13, Nutter et al. discloses wherein a form is published on an accessible information network and displays at least one of the plurality of value drivers (See paragraphs 0021, 0039, figures 7, 11, wherein a form is accessible via an information network and displays parameters with which the user is able to interact and enter data).

As per claim 14, Nutter et al. teaches wherein the form is operative to submit the plurality of user-specified variables in response to the value drivers for each of the entered opportunity (See paragraphs 0021-22, 0025-6, 0039, which discloses a user inputting variables into the system in response to the parameters).

However, Nutter et al. does not expressly disclose submitting the variables to a database.

Nutter et al. discloses a database coupled to the tool (and processor) that stores data

concerning the evaluation as well as calculating an opportunity value for each entered

opportunity using a scoring function. Databases are old and well known in the art for collecting

and organizing information so that it can easily be accessed and used, managed, and updated.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the

invention to store the variables of Nutter et al. in the database of the system in order to more

easily eliminate intellectual properties from licensing choices using the computer and the

organization provided by the database. See paragraphs 0019, 0021, which discusses the use of

databases and computers to more easily access the opportunities.

As per claim 15, Nutter et al. teaches wherein the system receives the user-specified

variables in response to the value drivers and to calculate a module score for at least one module

and a total score for each of the entered opportunity (See paragraphs 0019, 0022, 0025-8, 0031,

0039, wherein a score and total score is calculated. See also figure 13).

However, Nutter et al. does not expressly disclose a database is operative to store

variables.

Nutter et al. discloses a database coupled to the tool (and processor) that stores data

concerning the evaluation as well as calculating an opportunity value for each entered

opportunity using a scoring function. Databases are old and well known in the art for collecting

and organizing information so that it can easily be accessed and used, managed, and updated.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the

invention to store the variables of Nutter et al. in the database of the system in order to more

easily eliminate intellectual properties from licensing choices using the computer and the

organization provided by the database. See paragraphs 0019, 0021, which discusses the use of

databases and computers to more easily access the opportunities.

As per claim 16, Nutter et al. teaches wherein the calculated total score is a pre-

determined weighted average of the module scores for each of the entered opportunity (See

paragraphs 0025, 0027, 0039, wherein a weighted average is calculated).

As per claim 17, Nutter et al. discloses wherein the calculated module score is a pre-

determined weighted average of the user-specified variables within a module for each of the

entered opportunity (See paragraphs 0025, 0027, 0039, wherein a weighted average is

calculated).

As per claim 18, Nutter et al. discloses notifying a recipient about the entered opportunity

and corresponding total and module scores (See figure 13, paragraphs 0021, 0038, 0041-4,

wherein the recipient is notified via output of the total and separate scores).

However, Nutter et al. does not expressly disclose a database operative to notify

recipients.

Nutter et al. discloses a database coupled to the tool (and processor), calculating an

opportunity value for each entered opportunity using a scoring function, and notifying a recipient

via output of the total and separate scores. Databases are old and well known in the art for

collecting and organizing information so that it can easily be accessed and used, managed, and

updated. Further, it is old and well known to store notification templates linked with data in the

database. herefore, it would have been obvious to one of ordinary skill in the art at the time of

the invention that the database of Nutter et al. would be operative to notify the recipients in order

to more easily eliminate intellectual properties from licensing choices using the computer and the

organization provided by the database. See paragraphs 0019, 0021, which discusses the use of

databases and computers to more easily access the opportunities.

Claims 26-28, 31, and 33-38 recite equivalent limitations to claims 1-3, 11, and 13-18,

respectively, and are therefore rejected using the same art and rationale relied upon above.

6.   Claims 4-8, 19-25, 29-30, 39, and 41-42 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Nutter et al. (U.S. 2002/0178029) in view of Elliott (U.S. 2001/0042034).

As per claims 4-8, Nutter et al. discloses calculating an opportunity value for each

opportunity using a pre-determined function using variables related to various factors (See

paragraphs 0019, 0021, 0026, 0028, 0030-1, 0034, wherein a function is used to calculate a value

based on the input variables by the user and the values are ranked, sorted, and/or prioritized).

However, while Nutter et al. teaches a plurality of licensing and market factors, Nutter et

al. does not expressly disclose ownership of the entered opportunity, available resources to be

applied to development, development cost, development time, implementation cost, and

implementation time, financial needs, implications, and cost feasibility as the specific factors

used.

Elliott discloses:

As per claim 4, value drivers relating to ownership of the entered opportunity (See

paragraphs 0020-2, which discloses ownership of the licensing opportunity).

As per claim 5, value drivers relating to available resources to be applied to development of the entered opportunity (See paragraphs 0009, 0034, 0111, 0155-6, 0163, which discloses development and the money needed for the development).

As per claim 6, a cost module having a plurality of value drivers relating to financial needs, implications, and cost feasibility of the entered opportunity (See paragraphs 0034-5, 0111, 0117-8, 0121-2, which discloses cost consideration).

As per claim 7, value drivers relating to development cost and development time of the entered opportunity (See paragraphs 0009, 0034, 0111, 0149, 0155-6, 0163, which discloses development, the money needed for the development, and the years of development).

As per claim 8, value drivers relating to implementation cost and implementation time of the entered opportunity (See paragraphs 0111, 0150-2, 0155-6, 0157-9, 0163, which discloses manufacturing, materials, and operation costs, as well as years of sales and years of expenses).

Nutter et al. discloses rating a licensing opportunity using a scoring function including factors related to the market and industry in which the opportunity resides. Elliott discloses valuation of intellectual property using factors such as ownership of the entered opportunity, available resources to be applied to development, development cost, development time, implementation cost, and implementation time, financial needs, implications, and cost feasibility. It would have been obvious to one of ordinary skill in the art at the time of the invention to include the factors of ownership of the entered opportunity, available resources to be applied to development, development cost, development time, implementation cost, and implementation time, financial needs, implications, and cost feasibility with the factors used in the scoring function of Nutter et al. in order to more efficiently evaluate intellectual properties and eliminate

intellectual properties that do not score as well as others based on the same evaluation factors.
See paragraph 0019, 0026, of Nutter et al.

As per claim 19, Nutter et al. teaches a system to prioritize licensing opportunities by
assigning a relative calculated value to every opportunity, said tool comprising:

a plurality of modules each having a plurality of value drivers (See figure 7, paragraphs
0025, 0029, 0039, which discusses the system storing parameters that drive value), said plurality
of modules comprising:

a market module having a plurality of value drivers relating to the marketability of the
entered opportunity (See figure 7, paragraphs 0028-32 and 0034, wherein the market of the
opportunity is considered in the evaluation);

an efficiency module having a plurality of value drivers relating to efficiency of the
entered opportunity (See figure 7, 13, paragraphs 0025, 0030, 0034, which at least discloses ease
of investigation, strength of claims, all of which are directed towards the effectiveness of the
opportunity); and

an impact module having a plurality of value drivers relating to overall impact of the
entered opportunity on the licensee product and licensee customers (See paragraph 0034, which
discloses considering the impact of the license on the products of the customer using the license);

a plurality of user-specified variables, linked to pre-determined weighting factors, in
response to the value drivers (See paragraphs 0019, 0022, 0025-6, 0039, which discloses a user
inputting variables into the system in response to the parameters. See paragraphs 0025, 0027,
0030, which discloses weighting factors used in the scoring of the value drivers);

a database coupled to the tool that stores data concerning the evaluation (See figures 1 and 2, paragraphs 0021, 0046); and

a processor operative to calculate an opportunity value for each entered opportunity by a pre-determined function using the user-specified variables and prioritizing the calculated opportunity values (See paragraphs 0019, 0021, 0026, 0028, 0030-1, wherein a function is used to calculate a value based on the input variables by the user and the values are ranked, sorted, and/or prioritized).

However, Nutter et al. does not expressly disclose storing the calculated opportunity values for each entered opportunity. Nutter et al. further does not expressly disclose that the plurality of modules includes a cost module having a plurality of value drivers relating to financial needs, implications, and cost feasibility of the entered opportunity.

Elliott discloses value drivers relating to financial needs, implications, and cost feasibility of the entered opportunity (See paragraphs 0034-5, 0111, 0117-8, 0121-2, which discloses cost consideration).

However Elliott does not expressly disclose storing the calculated opportunity values for each entered opportunity.

Nutter et al. discloses a database coupled to the tool (and processor) that stores data concerning the evaluation as well as calculating an opportunity value for each entered opportunity using a scoring function. Databases are old and well known in the art for collecting and organizing information so that it can easily be accessed and used, managed, and updated. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to store the calculated opportunity values (which are manipulated by the computer of

Nutter et al.) in the database of the system in order to more easily eliminate intellectual

properties from licensing choices by use of the computer. See paragraphs 0019, 0021, which

discusses the use of databases and computers to more easily access the opportunities.

Further, Nutter et al. discloses rating a licensing opportunity using a scoring function

including factors related to the market and industry in which the opportunity resides. Elliott

discloses valuation of intellectual property using factors such as financial needs, implications,

and cost feasibility. It would have been obvious to one of ordinary skill in the art at the time of

the invention to include the factors financial needs, implications, and cost feasibility with the

factors used in the scoring function of Nutter et al. in order to more efficiently evaluate

intellectual properties and eliminate intellectual properties that do not score as well as others

based on the same evaluation factors. See paragraph 0019, 0026, of Nutter et al.

Claim 20 recites equivalent limitations to the combination of claims 4 and 5 and is

rejected using the same art and rationale relied upon above.

Claim 21 recites equivalent limitations to the combination of claims 7 and 8 and is

rejected using the same art and rationale relied upon above.

Claims 22 and 23 recite equivalent limitations to claims 10 and 12, respectively, and are

therefore rejected using the same art and rational set forth above.

Claim 24 recites equivalent limitations to the combination of claims 13 and 14 and is

rejected using the same art and rationale relied upon above.

Claim 25 recites equivalent limitations to the combination of claims 14, 17, and 18 and is

rejected using the same art and rationale relied upon above.

Claims 29 and 30 recite equivalent limitations to claims 6 and 9, respectively, and are therefore rejected using the same art and rational set forth above.

As per claim 39, Nutter et al. discloses a method to prioritize licensing opportunities by assigning a relative calculated value to every opportunity, the method comprising the steps of:

providing a plurality of modules each having a plurality of value drivers (See figure 7, paragraphs 0025, 0029, 0039, which discusses the system storing parameters that drive value), said plurality of modules comprising:

a market module having a plurality of value drivers relating to the marketability of the entered opportunity (See figure 7, paragraphs 0028-32 and 0034, wherein the market of the opportunity is considered in the evaluation);

an efficiency module having a plurality of value drivers relating to efficiency of the entered opportunity (See figure 7, 13, paragraphs 0025, 0030, 0034, which at least discloses ease of investigation, strength of claims, all of which are directed towards the effectiveness of the opportunity);

an impact module having a plurality of value drivers relating to overall impact of the entered opportunity on the licensee product and licensee customers (See paragraph 0034, which discloses considering the impact of the license on the products of the customer using the license

applying pre-determined weighting factors to each of the plurality of value drivers (See paragraphs 0025, 0027, 0030, which discloses weighting factors used in the scoring of the value drivers);

a published form on an accessible information network that displays at least one of the plurality of value drivers (See paragraphs 0021, 0039, figures 7, 11, wherein a form is accessible

via an information network and displays parameters with which the user is able to interact and

enter data);

providing a plurality of user-specified variables, linked to pre-determined weighting

factors, in response to the value drivers (See paragraphs 0019, 0022, 0025-6, 0039, which

discloses a user inputting variables into the system in response to the parameters. See paragraphs

0025, 0027, 0030, which discloses weighting factors used in the scoring of the value drivers);

calculating a total score and module scores for each entered opportunity by a pre-

determined function using the user-specified variables (See paragraphs 0019, 0021, 0026, 0028,

0030-1, wherein a function is used to calculate a score value based on the input variables);

a database coupled to the tool that stores data concerning the evaluation (See figures 1

and 2, paragraphs 0021, 0046); and

notifying a recipient about the entered opportunity and corresponding total and

module scores (See figure 13, paragraphs 0021, 0038, 0041-4, wherein the recipient is notified

via output of the total and separate scores); and

prioritizing the calculated opportunity values (See paragraphs 0019, 0021, 0026, 0028,

0030-1, wherein a scores and data are used to rank, sort, and/or prioritize).

However, Nutter et al. does not expressly disclose storing the calculated opportunity

values for each entered opportunity. Nutter et al. further does not expressly disclose that the

plurality of modules includes a cost module having a plurality of value drivers relating to

financial needs, implications, and cost feasibility of the entered opportunity.

Elliott discloses value drivers relating to financial needs, implications, and cost feasibility of the entered opportunity (See paragraphs 0034-5, 0111, 0117-8, 0121-2, which discloses cost consideration).

However Elliott does not expressly disclose storing the calculated opportunity values for each entered opportunity.

Nutter et al. discloses a database coupled to the tool (and processor) that stores data concerning the evaluation as well as calculating an opportunity value for each entered opportunity using a scoring function. Databases are old and well known in the art for collecting and organizing information so that it can easily be accessed and used, managed, and updated. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to store the calculated opportunity values (which are manipulated by the computer of Nutter et al.) in the database of the system in order to more easily eliminate intellectual properties from licensing choices by use of the computer. See paragraphs 0019, 0021, which discusses the use of databases and computers to more easily access the opportunities. Further, Nutter et al. discloses rating a licensing opportunity using a scoring function including factors related to the market and industry in which the opportunity resides. Elliott discloses valuation of intellectual property using factors such as financial needs, implications, and cost feasibility. It would have been obvious to one of ordinary skill in the art at the time of the invention to include the factors financial needs, implications, and cost feasibility with the factors used in the scoring function of Nutter et al. in order to more efficiently evaluate intellectual properties and eliminate intellectual properties that do not score as well as others based on the same evaluation factors. See paragraph 0019, 0026, of Nutter et al.

As per claim 41, Nutter et al. teaches wherein the published form is network enabled

form that displays at least one of the plurality of value drivers and is operative to receive the

plurality of user-specified variables in response to the value drivers (See paragraphs 0021, 0039,

figures 7, 11, wherein a form is accessible via an information network and displays parameters

with which the user is able to interact and enter data. See also paragraphs 0025-6. A user inputs

variables into the system in response to the parameters).

However, Nutter et al. does not expressly disclose submitting the variables to a database

or that the form is web enabled and multi-layered.

Nutter et al. discloses a database coupled to the tool (and processor) that stores data

concerning the evaluation as well as calculating an opportunity value for each entered

opportunity using a scoring function. Nutter et al. further discloses an automated form that is

network enabled and also for the collection of input data. Databases are old and well known in

the art for collecting and organizing information so that it can easily be accessed and used,

managed, and updated. Also, the web is a well known network in the art allowing for more

efficient connections with remote locations. Finally, it is old and well known in the art to use

layering in programming for better organization by separating functional components that

interact in some sequential and hierarchical way. Therefore, it would have been obvious to one

of ordinary skill in the art at the time of the invention to store the variables of Nutter et al. in the

database of the system in order to more easily eliminate intellectual properties from licensing

choices using the computer and the organization provided by the database. See paragraphs 0019,

0021, which discusses the use of databases and computers to more easily access the

opportunities. Further, it would have been obvious to one of ordinary skill in the art at the time

of the invention to use the web and layering in the form of Nutter et al. in order to more

efficiently implement the system of Nutter et al. by using well known computing means that

allow for better efficiency in communications.

Claim 42 recites equivalent limitations to the combination of claims 14, 17, and 18, and is

therefore rejected using the same art and rationale set forth above.

7.   Claims 12 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nutter

et al. (U.S. 2002/0178029) in view of Wilkinson et al. (U.S. 2002/0099637).

As per claim 12, Nutter et al. discloses calculating an opportunity value for each

opportunity using a pre-determined function using variables related to various factors (See

paragraphs 0019, 0021, 0026, 0028, 0030-1, 0034, wherein a function is used to calculate a value

based on the input variables by the user and the values are ranked, sorted, and/or prioritized).

However, while Nutter et al. teaches a plurality of licensing and market factors, Nutter et

al. does not expressly disclose spin-off ideas, development challenges, and deficiencies as

specific factors used.

Wilkinson et al. discloses a plurality of value drivers relating to spin-off ideas,

development challenges, and deficiencies of the entered opportunity (See paragraphs 0019-20,

0028-9, 0037, 0054).

Nutter et al. discloses rating a licensing opportunity using a scoring function including

factors related to the market and industry in which the opportunity resides. Wilkinson et al.

discloses valuation of intellectual property using factors such as spin-off ideas, development

challenges, and deficiencies. It would have been obvious to one of ordinary skill in the art at the

time of the invention to include the factors of spin-off ideas, development challenges, and

deficiencies with the factors used in the scoring function of Nutter et al. in order to more

efficiently evaluate intellectual properties and eliminate intellectual properties that do not score

as well as others based on the same evaluation factors. See paragraph 0019, 0026, of Nutter et

al.

Claim 32 recites equivalent limitations to claim 12, and is therefore rejected using the

same art and rationale set forth above.

8.   Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nutter et al. (U.S.

2002/0178029) in view of Elliott (U.S. 2001/0042034) and in further view of Wilkinson et al.

(U.S. 2002/0099637).

As per claim 40, neither Elliot of Nutter et al. disclose a plurality of value drivers relating

to spin-off ideas, development challenges, and deficiencies of the entered opportunity.

Wilkinson et al. discloses a plurality of value drivers relating to spin-off ideas,

development challenges, and deficiencies of the entered opportunity (See paragraphs 0019-20,

0028-9, 0037, 0054).

Nutter et al. and Elliot both disclose valuing an intellectual asset based on various factors,

the factors used in scoring the opportunities. Wilkinson et al. also discloses valuation of

intellectual property using factors such as spin-off ideas, development challenges, and

deficiencies. Therefore, it would have been obvious to one of ordinary skill in the art at the time

of the invention to include the factors of spin-off ideas, development challenges, and deficiencies

with the factors used in the scoring function of Nutter et al., along with the other factors

disclosed by Elliot, in order to more efficiently evaluate intellectual properties and eliminate

intellectual properties that do not score as well as others based on the same evaluation factors.

See paragraph 0019, 0026, of Nutter et al.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

Contractor (U.S. 2004/0158473) discloses calculating a value by evaluating the licensing

of a product.

Del Vecchio et al. (U.S. 20030036945) discloses assessing an intellectual property (IP)

asset by collecting data concerning the IP and generating a report.

Hagelin (U.S. 2002/0077835) teaches different methods and considerations when valuing

intellectual property assets.

Donner (U.S. 6,263,314) teaches evaluating an intellectual property using a network

based tool, where an IP worth index is calculated.

Hartung et al. (U.S. 2003/0074291) discloses evaluating a development project based on

models and weighting factors.

Barney et al. (U.S. 6,556,992) discloses a system for valuation of patents and other

intangible assets based on breadth, commercial relevance, and defensibility.

Wilkinson (U.S. 2001/0034695) teaches valuation of intellectual property assets based on

a classification, valuation data, and computing a value for the asset.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beth Van Doren whose telephone number is (571) 272-6737. The examiner can normally be reached on M-F, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

bvd
August 28, 2006

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